

Serial No. 09/653,381
Page 6 of 14

REMARKS

This response is intended as a full and complete response to the final Office Action mailed December 1, 2005. In the Office Action, the Examiner notes that claims 1-25 are pending and rejected. By this response, Applicants have amended claims 1, 14 and 20; added new claim 28; and cancelled claim 24.

This response also includes a statement of the substance of an interview held on January 30, 2006.

In view of the foregoing amendments and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Amendments to the Claims and the New Claims

By this response, Applicants have amended claims 1, 14 and 20; added new claim 28; and cancelled claim 24. The amendments to the claims, as well as the new claim, are fully supported by the Application as originally filed.

For example, the amendments to the claims are supported at least by page 44, lines 16-29 of the Specification and originally filed claim 24. New claim 28 is supported at least by page 43, line 33, to page 44, line 15.

Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments.

Furthermore, at least the amendments to claim 20 have been previously presented and considered by the Examiner in the form of claim 24, and thus should be entered in response to the Final Office Action for consideration of the patentability thereof.

417073-1

Serial No. 09/653,381

Page 7 of 14

35 U.S.C. §103 Rejection of Claims 1-14, 17 and 19-25

The Examiner has rejected claims 1-14, 17 and 19-25 under 35 U.S.C. §103(a) as being unpatentable over Wang (U.S. Patent 6,675,385, hereinafter "Wang") in view of Legall et al. (U.S. Patent 6,005,565, hereinafter "Legall"). Applicants respectfully traverse the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. However, the Wang and Legall references, alone or in combination, fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest Applicants' invention as a whole.

Specifically, the Wang and Legall references fail to teach or suggest at least "receiving, from service provider equipment, a search object comprising a video slice encoded by a service provider, said search object being for an interactive program guide (IPG)," as recited in the claim as amended.

The Wang reference discloses, generally speaking, formatting EPG data as HTML web pages and broadcasting the HTML-format EPG in an MPEG-2 data stream. However, the Wang reference fails to teach or suggest receiving a search object from a service provider. Furthermore, the Wang reference fails to teach or suggest wherein the search object is encoded by a service provider as a video slice.

Furthermore, the Legall reference fails to bridge the substantial gap between the Wang reference and the Applicants invention as recited in claim 1. The Legall reference discloses a "power search tool that enables a user to search an electronic program guide and other information resources with one search" (abstract). However, the Legall reference does not teach or suggest that the power search tool is received from a service provider. Furthermore, the Legall reference does not teach or suggest that the power search tool is encoded by a service provider as a video slice.

Moreover, the Examiner has failed to provide a valid motivation to combine the Wang and Legall references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (see MPEP 2143.01(I) and 2143.01(III))

Serial No. 09/653,381

Page 8 of 14

The Examiner alleges the motivation to combine the Wang and Legall references is "to allow a user to 'perform searches that can be carried across a variety of information platforms' (Col 1, Lines 26-27)" (pages 5-6 of the 12/1/05 Office Action), citing a portion of the Legall reference. However, the Applicants respectfully submit that this is not a valid motivation to incorporate elements of the Legall reference into the Wang reference because the Wang reference already describes many aspects similar to those relied upon by the Examiner in the Legall reference. For example, the Wang reference discloses (emphasis added below):

"Electronic program guide (EPG) systems are known. A typical electronic program guide system, embodied in a settop box such as a satellite receiver or cable TV decoder (or in the TV receiver itself), receives a database of TV programming information (basic EPG data) encoded in a digital data format, broadcast over a satellite, cable or terrestrial channel. For example, one type of EPG system broadcasts a digital database of EPG data in the vertical blanking interval of an analog television signal. The EPG database is received at the settop, decoded locally and stored in local memory.

Responsive to viewer requests, the locally stored EPG database in local memory is then formatted from basic EPG data into a program guide EPG display form that can be displayed on the TV screen. The simplest EPG display is a TV programming grid, organized as channel versus time, similar to the typical programming grid appearing in a printed paper television guide. The locally stored basic EPG data is typically searched and sorted responsive to each viewer request, and the resulting guide information is generated and displayed on the TV screen. For example, the viewer may request a list of all sports events, or a list of all movies broadcast on that day, or on a future day. Responsive to each request, the processor in the settop searches, sorts and formats the locally stored EPG database into a customized EPG display.

Prior art EPG systems typically require a large local memory to store the EPG database, and a fast local processor to search, sort and display the EPG data.

In comparison with printed TV program guides, electronic program guides offer larger capacity, electronic searching, last minute updates, and other features such as searching and sorting that are not practical with printed paper guides. More recently, on line television guides via the Internet provide an alternative to on-screen television guides and printed paper guides. However, Internet services and on-line TV guides are

Serial No. 09/653,381

Page 9 of 14

designed for a two-way network model, as compared to broadcast TV and associated on-screen TV guides, which are designed for a one way network model.

Despite the competition from paper television guides and personal computer on-line television guides, the broadcast TV screen is the best place to view program guide information. It is more convenient for viewers to search for TV related information on the TV itself, rather than in some other place, such as a paper magazine or a home office personal computer. The EPG feature has proven to be attractive to viewers, and is one of the most important data applications for TV networks. The present invention provides an EPG solution for a one way broadcast digital TV network." (column 1, line 24, to column 2, line 7)

Thus, the Wang reference already discloses searching EPG data locally at a set-top terminal and also searching online television guides via the Internet. Thus, the Legall reference offers no improvement over the disclosure of the Wang reference in regards to the relied upon elements. Therefore, because the Legall reference offers no improvement over the disclosure of the Wang reference in regards to the relied upon elements, it would not be desirable to incorporate the relied upon elements of the Legall reference into the Wang reference because there would be nothing to gain by doing so. Thus, there is no valid motivation to combine the Legall and Wang references.

The Applicants respectfully submit that the Examiner has failed to establish prima facie obviousness in regards to the claimed invention. The Wang and Legall references fail to teach each and every element as recited in claim 1. There is also no valid motivation to combine the Wang and Legall references.

As such, the Applicants respectfully submit that independent claim 1 is therefore patentable under 35 U.S.C. §103 over the Wang and Legall references. Furthermore, independent claim 20 has substantially similar relevant limitations as those discussed above in regards to claim 1, and therefore claim 20 is also patentable. Moreover, since all of the dependent claims depend, either directly or indirectly, from claims 1 or 20, and recite additional limitations thereof, these dependent claims are also patentable.

Serial No. 09/653,381
Page 10 of 14

35 U.S.C. §103 Rejection of Claims 15 and 16

The Examiner has rejected claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Legall and in further view of Leary (U.S. Patent 6,425,133, hereinafter "Leary"). Applicants respectfully traverse the rejection.

Claims 15 and 16 depend directly or indirectly from independent claim 1. Moreover, for at least the reasons discussed above, the Wang and Legall references fail to teach or suggest Applicants' invention as recited in claim 1. Accordingly, any attempted combination of the Wang and Legall references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claims 15 and 16 are not obvious and are patentable under 35 U.S.C. §103.

35 U.S.C. §103 Rejection of Claim 18

The Examiner has rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Legall and in further view of Thomas et al. (U.S. Patent 5,666,645, hereinafter "Thomas"). Applicants respectfully traverse the rejection.

Claim 18 depends directly or indirectly from independent claim 1. Moreover, for at least the reasons discussed above, the Wang and Legall references fail to teach or suggest Applicants' invention as recited in claim 1. Accordingly, any attempted combination of the Wang and Legall references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claim 18 is not obvious and is patentable under 35 U.S.C. §103.

Official Notices

The Examiner took numerous Official Notices in the 6/2/05 Office Action. For example see pages 6-8 and 10-11 of the 6/2/05 Office Action. Applicant traversed each Official Notice in the response filed 8/30/05. In the 12/01/05 Office Action, the Examiner alleges (emphasis added below):

"The Applicant fails to adequately traverse the Official Notices relied upon in the previous Office Action mailed June 2, 2005. To adequately

Serial No. 09/653,381
Page 11 of 14

traversed such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." (page 3 of the 12/01/05 Office Action)

The Applicants respectfully disagree with the Examiner's allegation that the Applicants failed to adequately traversed the Official Notices. The Examiner alleges that the Applicants failed to specifically point out the supposed errors in the Examiner's action, including why the noticed fact is not considered to be common knowledge or well-known in the art. However, the Applicants respectfully submit that the Applicants clearly pointed out the errors in the Examiner's Official Notices, including why the respective claim limitations were not considered the common knowledge or well-known in the art. For example, in the 8/30/05 response, the Applicants recited (emphasis added below):

"The Examiner alleges that certain apparatuses and/or methods are well known in the art. However, the Applicant respectfully disagrees. These apparatuses and/or methods may not be well know within the specific art of the present invention and as specifically recited in their respective claims. Furthermore, it may not be well known to combine the allegedly well known apparatuses and/or methods with other apparatuses and/or methods recited in the respective claims or in other claims from which the respective claims may depend."

Thus, the Applicants clearly stated that it may not be well-known to combine the claim limitations rejected using Official Notice with the limitations of the independent claims from which they depend. This is clearly a reason why the claimed limitations are not considered to be common knowledge or well-known in the art. To provide any more detail than this is not possible because it is not well-known to combine the claim limitations, and thus there would be no possible documentary evidence.

Thus, the Applicants respectfully submit that the Applicants did adequately traverse the Official Notices.

For the purposes of clarification, the previous traverse is expanded upon below.

On page 7 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claim 9. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the limitation of claim 9 with the limitations of claim 1. For example, it is believed to be not well-known

417073-1

Serial No. 09/653,381
Page 12 of 14

to use packet identifiers to identify video streams having search results within the context of the search method of claim 1.

On page 8 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claim 11. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the limitation of claim 11 with the limitations of claim 1. For example, it is believed to be not well-known to provide search results in a particular order of relevance within IPG pages within the context of the search method of claim 1.

On page 8 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claims 12 and 13. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the limitation of claims 12 and 13 with the limitations of claim 1. For example, it is believed to be not well-known to receive search results in an order based on scheduled showtimes, or to provide the search result having scheduled showtimes closest to the present time first, within the context of the search method of claim 1.

On page 9 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claim 14. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the limitation of claim 14 with the limitations of claim 1. For example, it is believed to be not well-known to receive search results as video slices generated via sliced based encoding and sent from headend within the context of the search method of claim 1.

On page 11 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claim 24. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the limitation of claim 24 with the limitations of claim 20. For example, it is believed to be not well-known that the search window object is composed as a video slice that is encoded via sliced based encoding within the context of the IPG page of claim 20.

On page 11 of the 12/01/05 Office Action, the Examiner takes Official Notice regarding claim 25. The Applicants respectfully traverse this Official Notice. This Official Notice is in error because it is believed to be not well-known to combine the

Serial No. 09/653,381
Page 13 of 14

limitation of claim 25 with the limitations of claim 20. For example, it is believed to be not well-known that the search window object is composed as a bitmap within the context of the IPG page of claim 20.

Furthermore, the Applicants respectfully request the Examiner to produce documental proof to substantiate each Official Notice. MPEP 2144.03 recites (emphasis added below):

"C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2)."

The Applicants respectfully submit that without such documentary evidence, the rejections cannot be maintained.

Statement of Substance of Interview

An interview concerning the present Application was held on January 30, 2006. The interview included Examiners John Manning and Scott Beliveau from the USPTO and Stephen Guzzi, representative of the Applicants.

The Applicants' representative wishes to thank the Examiners for the courtesies extended during the interview. During the interview, aspects of the pending claim

Serial No. 09/653,381
Page 14 of 14

language, the 35 U.S.C. §103 rejection in the 12/1/2005 Office action over the Wang and Legall references, and the Wang and Legall references were discussed. No agreement was reached regarding the claims.


CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Stephen Guzzi, at (732) 383-1405, or Eamon J. Wall, Esq., at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 1/31/06



Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808